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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,165	01/20/2004	Xiaofeng Gao	BS02-209-CON	6640

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EXAMINER

GAUTHIER, GERALD

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/759,165

Applicant(s)

GAO ET AL.

Examiner

Gerald Gauthier

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 41-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

1. **Claim(s) 56, 57, 59 and 60** are objected to as being improper because they are double of previous dependent claims. Correction is required.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claim(s) 41-60** are rejected under 35 U.S.C. 103(a) as being unpatentable over Zafar et al. (US 2004/0076272 A1) in view of Myers (US 2003/0131143 A1) and in further view of Fortman et al. (US 2003/0095643 A1).

Regarding **claim(s) 41, 48 and 55**, Zafar discloses a method, at an enhanced notification server, for notification of messages (FIG. 1 and paragraph 0004) comprising:

receiving a notification from a first message server, wherein the notification includes information related to an incoming message that is intended for a subscriber, wherein the notification further includes a first identification associating the subscriber with the first message server (FIG. 7 and paragraph 0075);

mapping the first identification to a second identification, wherein the second identification associates the subscriber with a second message server (FIG. 7 and paragraph 0076); and

forwarding the notification to the communications device in response to a determination that the user is available on communications device (FIG. 7 and paragraph 0076).

Zafar discloses sending a notification message via an instant message to the called party but fails determining at least one user preference setting.

However, Fortman teaches determining at least one user preference setting, wherein the at least one user preference setting indicates whether the subscriber desires to receive the incoming message with the notification (paragraph 0042).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Zafar using the teaching of subscriber profile data as taught by Fortman.

This modification of the invention enables the system to determine at least one user preference setting so that the user would benefit for receiving the notification with the message.

Zafar in combination with Fortman disclose sending a notification message via an instant message to the called party but fails to disclose determining availability of the communications device.

However, Myers teaches querying the second message server using the second identification, to determine availability of the subscriber on a communications device associated with the second message server (FIG. 1 and paragraph 0027).

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Zafar in combination with Fortman using the teaching of instant messaging notification handler as taught by Myers.

This modification of the invention enables the system to determine availability of the communications device so that the user would benefit for a real time notification of the message received.

Regarding **claim(s) 42, 49 and 56**, Zafar discloses a method, further comprising queuing the incoming message for a later delivery in response to a determination that user is currently not available on the communications device (FIG. 1 and paragraph 0076).

Regarding **claim(s) 43, 50 and 57**, Zafar discloses a method, wherein the first message server is a voicemail server (FIG. 1 and paragraph 0075).

Regarding **claim(s) 44, 51 and 58**, Zafar discloses a method, wherein the information related to an incoming messages includes one or more of the following: an identity of a sender of the incoming message, a date of the incoming message, a time of the incoming message, an a size of the incoming message (FIG. 1 and paragraph 0066).

Regarding **claim(s) 45, 52 and 59**, Zafar discloses a method, wherein the second message server is an instant messaging presence server (FIG. 1 and paragraph 0076).

Regarding **claim(s) 46, 53 and 60**, Zafar discloses a method, wherein the communications device is an instant messaging client (FIG. 1 and paragraph 0076).

Regarding **claim(s) 47 and 54**, Fortman teaches a method, further comprising, in response to a determination that the at least one user preference setting indicates that the subscriber prefers to receive the incoming message with the notification, attaching the incoming message to the notification (paragraph 0042).

### ***Response to Arguments***

6. Applicant's arguments with respect to **claim(s) 41-60** have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GERALD GAUTHIER  
PATENT EXAMINER  
g.g.  
February 21, 2006

  
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